

AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. Appln. No. 09/707,963
Attorney Docket No.: Q61597

REMARKS

Claims 1-23 and 25-29 are all the claims pending in the application. By this Amendment, Applicant amends claims 1, 12, and 20 to further clarify the invention. The amendments to claims 1, 12, and 20 were made for reasons of precision of language and consistency, and do not narrow the literal scope of the claims and thus do not implicate an estoppel in the application of the doctrine of equivalents.

I. Preliminary Matters

Applicant thanks the Examiner for returning the initialed forms PTO/SB/08 submitted with the Information Disclosure Statements filed on July 10, 2003 and March 23, 2005.

II. Summary of the Office Action

Claims 1, 3-10, 12, 13, 14, 16-23, and 25-29 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,366,784 to Hsueh (hereinafter "Hsueh") in view of U.S. Patent No. 6,466,799 to Torrey et al. (hereinafter "Torrey") and U.S. Patent No. 6,804,536 to Bultman (hereinafter "Bultman"). Applicant respectfully traverses this rejection in view of the following comments.

The initial burden of establishing that a claimed invention is *prima facie* obvious rests on the USPTO. *In re Rijckaert*, 9 F.3d 1531, 1532 (Fed. Cir. 1993). To make its *prima facie* case of obviousness, the USPTO must satisfy three requirements:

- a) the prior art relied upon, coupled with the knowledge generally available in the art at the time of the invention, must contain some suggestion or incentive that would have motivated an artisan to modify a reference or to combine references. *In re Thrif*, 298 F.3d 1357, 1363 (Fed. Cir. 2002).
- b) the proposed modification of the prior art must have had a reasonable expectation of success, as determined from the

vantage point of the artisan at the time the invention was made. *Amgen, Inc. v. Chugai Pharm. Co.*, 927 F.2d 1200, 1209 (Fed. Cir. 1991).

- c) the prior art reference or combination of references must teach or suggest all the limitations of the claims. *In re Vaeck*, 20 U.S.P.Q.2d 1438, 1442 (Fed. Cir. 1991); *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970).

The motivation, suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, the nature of a problem to be solved. *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). Alternatively, the motivation may be implicit from the prior art as a whole, rather than expressly stated. *Id.* Regardless, if the USPTO relies on an express or an implicit showing of motivation, the USPTO is obligated to provide particular findings related to its conclusion, and those findings must be clear and particular. *Id.* A broad conclusionary statement, standing alone without support, is not “evidence.” *Id.*; *see also, In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001).

In addition, a rejection cannot be predicated on the mere identification of individual components of claimed limitations. *In re Kotzab*, 217 F.3d 1365, 1371 (Fed. Cir. 2000). Rather, particular findings must be made *as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed*, emphasis added. *Id.*

A critical step in analyzing the patentability of claims pursuant to section 103(a) is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. *See In re Kotzab*, 55 USPQ2d 1313, 1316 (Fed. Cir. 2000) (*citing In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999)). Close adherence to this methodology is especially

important in cases where the very ease with which the invention can be understood may prompt one “to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher.” *Kotzab*, 55 USPQ2d at 1316 (quoting *W.L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983)).

Most if not all inventions arise from a combination of old elements, emphasis added. *In re Kotzab*, 55 USPQ2d at 1316 (citing *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998)). Thus, every element of a claimed invention may often be found in the prior art. *Id.* However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. *Id.* Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant. *In re Kotzab*, 55 USPQ2d at 1316 (citing *In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998); and *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984)).

There is no motivation to combine the references in a manner suggested by the Examiner. The Examiner alleges that one of ordinary skill in the art would have been motivated to include the control unit of Torrey into the system of Hsueh “in order to allow a user to place and receive wireless calls from the standard telephonic devices” (see page 3 of the Office Action). At the same time, the Examiner alleges that Hsueh teaches placing and receiving wireless calls from the telephone set 1 (see page 2 of the Office Action: the Examiner alleges that col. 2, line 61 to col. 3, line 6 of Hsueh discloses the specific multifunction telephone responding to the arrived call at said portable radiophone). Since allegedly Hsueh already teaches placing and receiving wireless

calls from the standard telephonic devices, then one of ordinary skill in the art would not have been motivated to combine the references in a manner indicated by the Examiner.

In fact, the purpose of Hsueh's disclosure is to adopt a telephone set 1 to receive wireless calls arriving to the wireless phone. In other words, Hsueh teaches having a plurality of telephone sets 1 receiving and placing calls via one wireless phone. In short, Hsueh already teaches receiving and placing wireless calls using the telephone set 1. That is, there is no purpose to add a control unit of Torrey to perform functions already performed by Hsueh.

Moreover, the Examiner alleges that one of ordinary skill in the art would have been motivated to modify the teachings of Hsueh and Torrey to include Bultman's control unit switching between two modes of communication to "consolidate the portable and fixed phone services into one system, thereby eliminating the need for multiple systems" (see page 4 of the Office Action). Hsueh, however, already discloses adopting a wired telephone set 1 to receive wireless calls and Torrey discloses a system that allows users to place wireless calls over their hand-held wireless communications device from telephones connected through-out their location, while keeping the convenience and flexibility of a hand-held communications device (col. 2, lines 13 to 18). It is Applicant's position that both Hsueh and Torrey, in one way or another, consolidate the portable and fixed phone services into one system *e.g.*, wireless system. Accordingly, the relevance of Bultman is not understood. It is Applicant's position that one of ordinary skill in the art would not have been motivated to include Bultman's control unit to the systems of Hsueh and Torrey.

For at least these exemplary reasons, it is respectfully submitted that there is no motivation to combine Hsueh, Torrey, and Bultman in the manner suggested by the Examiner.

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Therefore, the Examiner cannot fulfill the “motivational” prong of a *prima facie* case of obviousness, as required by *In re Thrif*.

In addition, the combined teachings of Hsueh, Torrey, and Bultman both fail teach or suggest all of the unique features of the claims, as required by the third prong in establishing a *prima facie* case of obviousness.

Of the rejected claims, only claims 1, 12, and 20 are independent. For example, independent claims 1, 12, and 20 recite some variation of: “wherein, when said specific multifunction telephone notifies said control unit of a call arrival at said portable radiophone, in response, said control unit switches said same specific multifunction telephone, provided said same specific multifunction telephone is available, from a wired line communication mode to a radio communication mode to answer a call addressed to said portable radiophone via said specific multifunction telephone.” Applicant respectfully submits that at least these unique features of claims 1, 12, and 20 are clearly absent from the combined teachings of Hsueh, Torrey, and Bultman.

The Examiner acknowledges that Hsueh fails to teach or suggest the control unit as set forth in the independent claims. The Examiner, however, alleges that Torrey discloses the multifunction telephone notifying the control unit of a call arrival at the portable radiophone and that Bultman discloses the control unit that switches a multifunction telephone from the wired line communication mode to the radio communication mode (*see* pages 2-4 of the Office Action). Applicant respectfully submits, however, that Bultman does not teach or suggest switching the telephone in response to the notification from this telephone.

In addition, it is Applicant's position that Torrey and Bultman fail to cure the deficient teachings of Hsueh. That is, Torrey and Bultman do not teach or suggest the multifunctional telephone notifying the control unit of a telephone call arriving at a portable phone and that, when possible, this multifunctional telephone is switched to a radio communication in response to said notification.

Torrey discloses a number of telephonic devices 231-235 (*e.g.*, telephones, facsimile machines, computers) connected to a premises converter 220 for placing and receiving telephonic calls over a wireless network 280 and a telephone network 290. Wireless telephonic calls can be made when hand-held wireless communications device 200 is located in premises station 210, which can either be a separate unit, or incorporated into premises converter 220.

In Torrey, the call processor 223, connected to premises station 210 via link 217, exchanges call signaling messages with the hand-held wireless communications device 200, converts incoming signals from the hand-held wireless communications device to incoming signals compatible with the first telephonic device, and converts outgoing signals from the first telephonic device to outgoing signals compatible with the hand-held wireless communications device (Fig. 2A; col. 4, lines 13 to 34).

Torrey, however, discloses using the premises station 210 of the wireless device 200 to notify the call processor 223 of an arriving call. The call processor 223 in its turn forwards the call to an appropriate telephonic device. In other words, Torrey, clearly fails to teach or suggest having a telephonic device 231-235 notify the alleged control unit (premise converter 220) of the received call. In fact, it is the premises converter which forwards the call to an appropriate telephonic device. That is, in Torrey, when a call arrives on a wireless device 200, the alleged

control unit (premises converter 120 or 220) processes the arriving call and forwards it to an appropriate telephonic device.

In short, Torrey does not teach or suggest a telephonic device notifying the premises converter of a call that is arriving at the wireless device. In addition, the Examiner acknowledges that Torrey does not teach or suggest switching the mode of the telephonic device in response to the notification (*see* page 3 of the Office Action).

The Examiner, however, alleges that Bultman cures the deficient teachings of Torrey (*see* page 3 of the Office Action). Applicant respectfully disagrees.

That is, Bultman discloses the microprocessor 1004 (the alleged control unit) monitoring the status of the wireless device 224 by monitoring an appropriate control signals, and thereby detecting an incoming call to the wireless device 224. That is, the microprocessor 1004 detects an incoming call to the wireless device 224. When the incoming call is detected, the microprocessor 1004 determines to which of the phone appliances 220 the wireless device should be connected. A hierarchy of choices may be preprogrammed in the microprocessor 1004. When the phone appliance 220 is determined and availability is confirmed, the microprocessor 1004 connects the incoming wireless call to the chosen phone appliance. If necessary, the microprocessor 1004 switches the switch module 1060 so that the wireless interface 1002 is coupled to the phone appliance interface 1034 (Figs. 10 and 11; col. 9, line 58 to col. 10, line 46).

Bultman fails to teach or suggest the phone appliance 220 notifying the microprocessor of an incoming call arriving at the wireless device. Moreover, Bultman fails to teach or suggest switching the phone the communication mode of the phone that notified the microprocessor.

That is, the phone appliance 220 is not switched in response to the notification. Instead, the multiprocessor simply determines which of the phone appliances 220 should be used based on a pre-programmed list. In short, Bultman fails to cure the deficient teachings of Hsueh and Torrey.

Therefore, “wherein, when said specific multifunction telephone notifies said control unit of a call arrival at said portable radiophone, in response, said control unit switches said same specific multifunction telephone, provided said same specific multifunction telephone is available, from a wired line communication mode to a radio communication mode to answer a call addressed to said portable radiophone via said specific multifunction telephone,” as set forth in some variation in claims 1, 12, and 20 are not suggested or taught by the combined teachings of Hsueh, Torrey, and Bultman which lack having the specific multifunction telephone notify the control unit of a call arriving at the portable radiophone and in response having the control unit switch a telephone set from wired to radio communication mode. For at least these exemplary reasons, Applicant respectfully submits that independent claims 1, 12, and 20 are patentable over the combined teachings of Hsueh, Torrey, and Bultman. Applicant, therefore, respectfully requests the Examiner to reconsider and withdraw this rejection of independent claims 1, 12, and 20. Claims 3-10, 13, 14, 16-19, 21-23, and 25-29 are patentable at least by virtue of their dependency on claim 1, 12 or 20.

Moreover, dependent claim 23 recites: “wherein said communication control section can respond to said arrived call at said portable phone through said connection control section without waiting for the permission when the permission is previously given.” The Examiner acknowledges that Hsueh does not teach or suggest this unique feature of claim 23. The Examiner, however, alleges that Torrey cures the deficient teachings of Hsueh (*see* page 11 of

the Office Action). Applicant respectfully disagrees. First, Applicant respectfully submits that Torrey's wired telephones do not have the communication control section and with respect to the independent claim 20 from which claim 23 depends, the Examiner cites Hsueh for this unique feature of the claim. Moreover, Applicant respectfully submits that the passages of Torrey noted by the Examiner do not teach or suggest "respond to said arrived call...without waiting for the permission when the permission is previously given." Bultman does not cure the deficient teachings of Hsueh and Torrey. For at least these additional reasons, claim 23 is patentable over the combined teachings of Hsueh, Torrey, and Bultman, taken alone or in any conceivable combinations.

In addition, dependent claim 27 recites: "the portable radiophone corresponds with only one multifunction telephone from said plurality of multifunction telephones." The Examiner alleges that this unique feature of the claim is disclosed by Fig. 1 of Hsueh. Applicant respectfully disagrees. Hsueh discloses a mobile phone extension set, where one mobile phone is associated with a number of wired telephones (col. 1, lines 35 to 61). Accordingly, Hsueh clearly does not teach a one to one correspondence between the mobile telephone and the wired telephones. If the Examiner maintains the position that Hsueh discloses a one to one correspondence between the wireless and wired telephone. Applicant respectfully requests the Examiner to explain how the PBX is *inherently*¹ formed in Hsueh, as alleged by the Examiner

¹ With respect to claim 26, Applicant respectfully notes that a *prima facie* case of obviousness under 35 U.S.C. § 103 cannot be established by applying the doctrine of inherency. Inherency plays no part in an obviousness rejection, because inherency and obviousness are entirely different concepts. In re Rinehart, 189 USPQ 143 (CCPA 1976). That which may be inherent is not necessarily known; and obviousness cannot be predicated on that which is unknown. See In re Adams, 148 USPQ 742 (CCPA 1966). Accordingly, reliance upon the doctrine of inherency is misplaced in the context of a § 103 rejection and ... (footnote continued)

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with respect to claim 26 (*see* page 12 of the Office Action). That is, Applicant respectfully submits that the position set forth in the Office Action with respect to claim 26 contradicts the position set forth with respect to claim 27. For at least this additional exemplary reason, Applicant respectfully submits that claim 27 is patentable over the combined teachings of Hsueh, Torrey, and Bultman, taken alone or in any conceivable combination.

In addition, dependent claim 28 recites: “where said one multifunction telephone further comprises a suspension tone source section for converting the radio signal of a radiophone network into a signal of the wired network, and vice versa.” The Examiner alleges that Bultman discloses a telephone having a suspension tone source section, as set forth in claim 28 (*see* page 12 of the Office Action). Applicant respectfully disagrees. Applicant respectfully submits that this position is inconsistent with the position set forth for the independent claim 20. With respect to claim 20, the Examiner alleges that Bultman’s microprocessor 1004 discloses the control unit (*see* page 10 of the Office Action). Bultman, however, discloses that the microprocessor 1004, when necessary, switches the switch module 1060 so that the wireless interface 1002 is coupled to the phone appliance interface 1034 (col. 10, lines 41 to 45). That is, in Bultman, the microprocessor performs all the necessary operations to switch the phone appliance from one mode to another. As is visible from Figs. 8-10B, the phone appliance 220 does not have a suspension tone source section that would convert one type of signal to another. For at least this additional exemplary reason, Applicant respectfully submits that claim 28 is patentable over the

does not satisfy the Examiner's burden of presenting a *prima facie* case of obviousness with respect to claim 26.

combined teachings of Hsueh, Torrey, and Bultman, taken alone or in any conceivable combination.

Dependent claim 29 recites: “said radiophone network is a Personal Digital Cellular telecommunication system or a personal handy-phone system.” The Examiner alleges that Fig. 1 of Hsueh discloses this unique feature of claim 29 (*see* page 13 of the Office Action). The Examiner’s position is not understood, as Fig. 1 simply discloses a mobile phone and a telephone set for the mobile phone. Applicant respectfully submits that this could be any wireless or radio phone. Applicant respectfully submits that Fig. 1 of Hsueh would not teach or suggest to one of ordinary skill in the art a particular system such as the systems recited in claim 29. For at least this additional exemplary reason, Applicant respectfully submits that claim 29 is patentable over the combined teachings of Hsueh, Torrey, and Bultman, taken alone or in any conceivable combination.

Next, dependent claims 2, 11, and 15 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the combined teachings of Hsueh, Torrey, Bultman, and applicant’s prior art (hereinafter “APA”). Claims 2, 11, and 15 depend on claim 1 or 12. It was already demonstrated that the combined teachings of Hsueh, Torrey, and Bultman do not teach or suggest all of the unique features of claims 1 and 12. Applicant respectfully submits that APA teaches that a multifunction telephone cannot receive calls addressed to a radiophone. Therefore, APA fails to teach or suggest that when a multifunction telephone notifies a control unit of a call received by the radiophone, in response, the control unit switches this multifunction telephone, when this multifunction telephone is available, to a different communication mode. As such

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APA clearly fails to cure the deficient teachings of Hsueh, Torrey, and Bultman. Accordingly, claims 2, 11, and 15 are patentable at least by virtue of their dependency.

IV. Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly invited to contact the undersigned attorney at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

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